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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,497

12/20/2004

Jun Kotani

35355/47

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23838

7590

08/29/2006

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary	Application No. 10/518,497	Applicant(s) KOTANI ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 1 to 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1712

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 15 to 22 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2000/55251, as interpreted by the English language equivalent Hakuta et al.

Hakuta et al. teach a crosslinkable rubber composition in which a vinyl polymer (specifically an ethylene/ α -olefin/non-conjugated polyene random copolymer), hydrosilyl group containing compound and hydrosilylation catalyst are present. See for instance column 7, lines 20 and on, and column 40, line 5 and on. This meets (A) to (C) in claim 1. The top of column 36 teaches the ratio found in instant claim 19.

Column 46, line 22 to 25, teach the addition of barium stearate, zinc stearate and calcium stearate as processing aids. This specific disclosure anticipates the addition of (D). In this manner the claimed curable composition is fully met by the teachings in Hakuta et al. This also meets the requirements of claims 16 and 17.

In addition to the disclosure on column 46, also note the working examples such as those found on Table 5. Note that these compositions include stearic acid and zinc white. This combination will form in situ a metal soap. In this manner too the claimed curable composition is fully met by the teachings in Hakuta et al.

For claim 15, see column 33, line 40 and on.

For claim 19, in addition to the top of column 36, see the preferred amount of not more than 5 parts by weight found on column 46, line 29. For claim 18, see column 44, lines 16 and on. Column 48 discloses curing the composition in a mold.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 1999/07803, as interpreted by the English language equivalent Fujita et al., further in view of WO 2000/55251, as interpreted by Hakuta et al.

Fujita et al. teach an curable composition that contains (A) – (C) as claimed. See for instance the bottom of column 3 and the catalysts on the bottom of column 21. The vinyl polymer (A) meets the requirements of claims 2 to 14. See for instance columns 4 and on, particularly the molecular weight distribution on the bottom of column 5 and the processes on the bottom of column 6 and on. See also column 9 which teaches the two methods of claims 12 and 13. This reference differs from that claimed in that it does not teach the presence of (D).

Hakuta et al. teach metal stearates such as zinc stearate function in comparable compositions as a processing aid.

Please note that It is prima facie obvious to add a known ingredient to a known composition for its known function. In view of this the skilled artisan would have found the addition of a zinc stearate processing aid to the composition in Fujita et al. to have been obvious. Processing aids are additives that facilitate processing and the skilled artisan would have recognized that this would be a desirable improvement for the composition in Fujita et al.

5. Claims 1 - 2 and 14 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusakabe et al. in view of WO 2000/55251, as interpreted by Hakuta et al.

This rejection relies on rationale comparable to that noted in paragraph 4, supra. Kusakabe et al. teach a process of making acrylic polymers having alkenyl functional end groups. See column 2, lines 35 and on, which teaches the specific preparation found in claim 12. See also the working examples, such as Example 1, which prepares a polymer having the molecular weight distribution of claim 2. Column 11, lines 60 and on, teaches the organohydrogen compound (B) while column 14, lines 1 and on, teaches the catalyst (C). This differs from that claimed in that it does not teach the presence of (D).

Hakuta et al. teach metal stearates such as zinc stearate function in comparable compositions as a processing aid.

Please note that It is prima facie obvious to add a known ingredient to a known composition for its known function. In view of this the skilled artisan would have found the addition of a zinc stearate processing aid to the composition in Kusakabe et al. to have been obvious. Processing aids are additives that facilitate processing and the skilled artisan would have recognized that this would be a desirable improvement for the composition in Kusakabe et al.

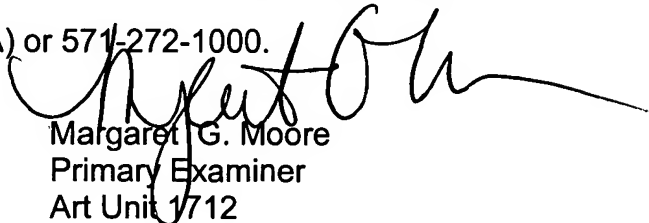
6. To establish that which is conventional and known in the art, the Examiner refers to column 8, line 66 of Davis et al., column 7, line 10 of Lee et al. and column 3, line 31 of Garcia Duran et al. Each of these references teach that zinc stearate is a known or commonly used processing aid. This supports the position of obviousness, above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
8/23/06